



04/25/05

PATENT Serial No: 09/803,928

Atty. Docket No: 11266/102

Appeal Brief

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2162

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Justin MOODIE, *et al.*

Serial No: 09/803,928

Filed: March 13, 2001

For: COMMUNICATIONS SYSTEM WITH DATABASE
MANAGEMENT

Examiner: E. P. LEROUX

Art Unit: 2162

APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Appellants submit this Appeal Brief in the above-referenced application. A Notice of Appeal was filed on March 1, 2005.

REAL PARTY IN INTEREST

Agency.com, Ltd. is the real party in interest for all issues related to this application.

RELATED APPEALS OR INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellants, Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

This application contains claims 27-38. Claims 27-38 stand finally rejected. Claims 27-38 are the subject of this appeal. Claims 1-26 are canceled.

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STATUS OF AMENDMENTS

A Response After Final Rejection Under 37 CFR §1.116 was filed in this application on December 30, 2004. An Advisory Action mailed February 9, 2005 states that the Response would not be entered because it raises new issues that would require further consideration and/or search. The Advisory Action further states that the Response was briefly considered and does not overcome the anticipation and obviousness rejections over prior art. No other amendments were filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

There are two independent claims involved in this appeal.

Independent claim 27 recites a method of indicating whether items on a shopping list are located in the vicinity of a shopper (page 4, ll. 18-29). A shopping list may be stored in a portable computer device, such as the Personal Digital Assistant (PDA) in Fig. 1 (page 4, ll. 19-24). For example, while shopping, a shopper may download a shopping list to the shopper's PDA by connecting to a web-enabled kiosk, shown as WK in Fig. 1, which gets the shopping list from the shopper's personal database. The PDA may receive a signal from a short-range, local wireless communications system located in a store (page 4, ll. 24-26) and may determine from the received signal whether any item on the shopping list is available in the store (page 4, ll. 27-29). For example, the shopper's PDA may receive a signal from transmitters positioned around the store that broadcast a list of the items available (page 4, ll. 24-26). In this example, the PDA may then determine which items on the shopper's shopping list match those broadcasted by the store's transmitters (page 4, ll. 26-28). If any of the items on the shopping list are determined to be available, the PDA may provide an indication of such to the device's user (page 4, ll. 27-29). For example, in one embodiment the PDA may alert the shopper by highlighting those items that are available and omitting highlights for those items that are not available. (Fig. 1; page 4, ll. 18-29).

Independent claim 33 recites a "machine readable medium," but otherwise is substantially similar to claim 27. In particular, independent claim 33 recites a machine readable medium having embodied thereon instructions executable by a processor to perform a method such as the method of claim 27 (Fig. 1, PDA; page 4, ll. 18-29). As in claim 27, a shopping list may be stored in a portable computer device, such as the PDA in Fig. 1 (page 4, ll. 19-24). The

portable computer device may receive a signal from a short-range, local wireless communications system located in a store (page 4, ll. 24-26) and may determine from the received signal whether any item on the shopping list is available (page 4, ll. 27-29). If any of the items on the shopping list are determined to be available, the portable computer device may provide an indication to the device's user that the item is available (page 4, ll. 27-29).

GROUND OF REJECTION TO BE REVIEWED

The Final Rejection (a) rejects claims 27-29, 31, 33-35, and 37 under 35 U.S.C. §102(e) as anticipated by Petrovich (USP 6,101,483); (b) rejects claims 30 and 36 under 35 U.S.C. §103(a) as obvious over Petrovich in view of Borgstrom (USP 6,783,053); and (c) rejects claims 32 and 38 under 35 U.S.C. §103(a) as obvious over Petrovich in view of Nambudiri (USP 6,650,214).

ARGUMENT

A. The rejections of claims 27-29, 31, 33-35, and 37 as anticipated by Petrovich are improper because Petrovich does not disclose whether an item is available

Claims 27-29, 31, 33-35, and 37 were rejected under 35 U.S.C. § 102 as anticipated by Petrovich. This rejection is not proper because Petrovich does not disclose each and every element of the claim, as is required for an anticipation rejection. See MPEP §2131. In particular, Petrovich does not disclose a method that determines “whether any item on the shopping list is available” or that “provid[es] an indication to the user of the portable computer device that the item is available,” as recited respectfully in claims 27 and 33 (emphasis added).

On the contrary, Petrovich merely indicates whether the user is not on an efficient path toward an item. In particular, Petrovich discloses communicating a message “advising the user 58 when the user 58 has deviated from the efficient path 104.” See Petrovich, col. 10, ll. 44-47. Petrovich is completely silent as to what message is communicated if the item is not available. If an audio tone is produced when a user deviates from an inefficient path, for example, the user would not be able to determine from such a tone whether the item is or is not available in the store. Thus, Petrovich does not teach or suggest determining whether an item is “available” in the store or providing an indication to the user that the item is “available” in the store, as recited in claims 27 and 33.

There is a clear distinction between Petrovich's method of directing a user through the store and Appellant's method of determining whether an item is available in the store. There is no teaching or suggestion in Petrovich that, if an item is not available in a store, a message is communicated to the user that the item is not available. By contrast, in Appellant's claimed method, if the item is not available in the store, the user is alerted that the item is not available, for example by an alert in the form of an absence of highlighting of the item on the user's PDA. See specification, page 4, ll. 27-29.

In response to Appellant's pointing out this distinguishing feature, the Advisory Action mailed February 9, 2005 states:

Petrovich's teaching that a shopper is guided through the store in an efficient manner according to the shopping list inherently means that that(sic) the shopper is provided with an indication that the item is available in the store. (emphasis added).

To be inherent in a reference, however, "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. . . ." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). The fact that something may occur given a set of circumstances is not sufficient to prove inherency. In re Oelrich, 666 F.2d 578, 581, 211 USPQ 323 (CCPA 1981). Moreover, to prove inherency of a claimed feature in a prior art reference, the Examiner must "provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." Ex parte Skinner, 2 USPQ2d 1788 (BAPI 1986).

Petrovich's method indicates whether the user is not on an efficient path toward an item. The steps of determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the store are not necessarily present in the method described in Petrovich. As discussed above, Petrovich could provide the same indication to when an item is not available in the store as when the user is not on an efficient path towards the item. Moreover, the Examiner has not provided any evidence or scientific reasoning to prove that Petrovich's method inherently teaches or suggests determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the

store, as recited in claims 27 and 33. If the item is not available in the store, it is not at all inherent that Petrovich's method communicates to the user that the item is not available.

For at least the above reasons, it is submitted that claims 27 and 33 are not anticipated by Petrovich. Claims 28, 29, 31, 34, 35, and 37 are not anticipated by Petrovich for the same reasons based on their dependency from these independent claims. Reversal of these rejections is requested.

B. The rejections of dependent claims 30 and 36 as obvious over Petrovich in view of Borgstrom should be reversed for the same reasons as claims 27 and 33

Claims 30 and 36 depend from one of claims 27 and 33. As discussed above, Petrovich fails to teach or suggest determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the store, as recited in claims 27 and 33. These deficiencies of Petrovich are not corrected by Borgstrom because Borgstrom also fails to teach or suggest determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the store, as recited in claims 27 and 33. The Examiner does not rely on Borgstrom for this teaching.

Moreover, even if a person of ordinary skill in the art were to combine Petrovich and Borgstrom, there is no evidence of a motivation to modify such a combined device as would be required to provide Appellants' claimed invention. See, e.g., In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693 (Fed. Cir. 2001) (holding that to support an obviousness rejection, there must be "concrete evidence in the record" of a motivation to combine or modify the references as asserted.) For obviousness purposes, the issue of motivation must be supported by citations to some authority and may not be resolved "on subjective belief and unknown authority." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430 (Fed. Cir. 2002). Here, even if Petrovich and Borgstrom were combined, there is no evidence of record which would teach or suggest to a person of ordinary skill in the art a step of determining whether an item is "available" in the store or of providing an indication to the user that the item is "available" in the store, as recited in claims 27 and 33.

For at least the above reasons, claims 30 and 36 are not obvious over Petrovich in view of Borgstrom. Reversal of these rejections is requested.

C. Rejections of claims 32 and 38 as obvious over Petrovich in view of Nambudiri should be reversed for the same reasons as claims 27 and 33

Claims 32 and 38 depend from one of claims 27 and 33. As stated previously, Petrovich fails to teach or suggest determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the store, as recited in claims 27 and 33. These deficiencies of Petrovich are not corrected by Nambudiri. Nambudiri discloses generating a list of ingredients in a recipe and storing the list to a portable terminal. See, e.g., Nambudiri, col. 12, ll. 36-39. However, Nambudiri does not teach or suggest determining whether an item is "available" in the store or providing an indication to the user that the item is "available" in the store, as recited in claims 27 and 33. Therefore, combining Nambudiri with Petrovich would still not provide Appellants' claimed invention.

Moreover, even if a person of ordinary skill in the art were to combine Petrovich and Nambudiri, there is no evidence of a motivation to modify such a combined device as would be necessary to provide Appellants' claimed invention, as required by the cases discussed above.

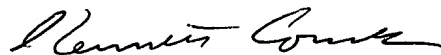
For at least the above reasons, claims 32 and 38 are not obvious over Petrovich in view of Nambudiri. Reversal of these rejections is requested.

CONCLUSION

Appellants respectfully request reversal of the rejections of claims 27-38. These claims are allowable over the cited art.

Respectfully submitted,

Date: April 22, 2005



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CLAIMS APPENDIX

1 – 26 (Cancelled).

27. A method of indicating whether items on a shopping list are located in the vicinity of a shopper, the method comprising:

storing a shopping list in a portable computer device, wherein the shopping list comprises a plurality of items;

receiving a signal at the portable computer device from a short-range, local wireless communications system located in a store;

determining from the received signal at the portable computer device whether any item on the shopping list is available in the store; and

if any of the items on the shopping list are determined to be available in the store, providing an indication to a user of the portable computer device that the item is available in the store.

28. The method of claim 27, wherein the short-range, local wireless communication signal is sent from a location in the store that is within the vicinity of the portable computer device, and wherein the indication provided to a user indicates that the item is within the vicinity of the user.

29. The method of claim 27, wherein the portable computer device is a personal digital assistant.

30. The method of claim 27, wherein the short-range, local wireless communications system complies with the Bluetooth communications standard.

31. The method of claim 27, wherein the step of storing a shopping list in the portable computer device comprises downloading the shopping list from the Internet at a location inside of the store.

32. The method of claim 27, wherein the step of entering a shopping list in the portable computer device comprises:

receiving a selection of a recipe from a user;
determining a list of items based on ingredients specified in the recipe; and
storing the list of items on the portable computer device.

33. A machine readable medium having embodied thereon instructions executable by a processor to perform a method, the method comprising:

storing a shopping list in a portable computer device, wherein the shopping list comprises a plurality of items;

receiving a signal at the portable computer device from a short-range, local wireless communications system located in a store;

determining from the received signal at the portable computer device whether any item on the shopping list is available in the store; and

if any of the items on the shopping list are determined to be available in the store, providing an indication to a user of the portable computer device that the item is available in the store.

34. The machine readable medium of claim 33, wherein the short-range, local wireless communication signal is sent from a location in the store that is within the vicinity of the portable computer device, and wherein the indication provided to a user indicates that the item is within the vicinity of the user.

35. The machine readable medium of claim 33, wherein the portable computer device is a personal digital assistant.

36. The machine readable medium of claim 33, wherein the short-range, local wireless communications system complies with the Bluetooth communications standard.

37. The machine readable medium of claim 33, wherein the step of storing a shopping list in the portable computer device comprises downloading the shopping list from the Internet at a location inside of the store.

38. The machine readable medium of claim 33, wherein the step of entering a shopping list in the portable computer device comprises:

receiving a selection of a recipe from a user;
determining a list of items based on ingredients specified in the recipe; and
storing the list of items on the portable computer device.

EVIDENCE APPENDIX

There is no evidence provided pursuant to Rule 1.130, 1.131, or 1.132, or any evidence entered by the Examiner and relied upon by Appellants.

RELATED APPEALS APPENDIX

There are no other appeals, interferences, or judicial proceedings known to Appellants, Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO
APR 22 2005
Patent & Trademark Office

FEE TRANSMITTAL

for FY 2005

Effective 10/1/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) **500.00**

Complete if Known	
Application Number	09/803,928
Filing Date	March 13, 2001
First Named Inventor	MOODIE et al
Examiner Name	E.P. Leroux
Art Unit	2162
Attorney Docket No.	11266/102

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None
Order

☒ Deposit Account:

Deposit Account Number: **11-0600**

Deposit Account Name: **KENYON & KENYON**

The Director is authorized to: (check all that apply)
☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or any underpayment of fee(s)
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$) N/A

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims: **30** ** = **0** X **50** = **0**

Independent Claims: **5** ** = **0** X **200** = **0**

Multiple Dependent: **0** X **0** = **0**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	50	2202	25	Claims in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203		2203		Multiple dependent claim, if not paid	
1204		2204		** Reissue independent claims over original patent	
1205		2205		** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$) 0

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	500.00
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					
*Reduced by Basic Filing Fee Paid					
SUBTOTAL (3)					(\$) 500.00

SUBMITTED BY

Name (Print/Type)		Registration No. (Attorney/Agent)		Telephone	
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Signature		Date		April 22, 2005	